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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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UBS AG
v.
UFS Securities, L.L.C.

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Opposition No. 91150775
to application Serial Nos. 76203687 and 76203688
filed on February 2, 2001

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Paul W. Kruse, Kevin Kramer, James R. Menker and Thomas P. Feddo of Pillsbury Winthrop for UBS AG.

Denise C. Mazour of Thomte, Mazour & Niebergall for UFS Securities, L.L.C.

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Before Hairston, Walters and Chapman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

UFS Securities, L.L.C. (a Nebraska limited liability company) has filed applications to register the marks UFS SECURITIES (typed drawing) and UFS SECURITIES as shown below,

both for "securities brokerage services."[1]

Opposer, UBS AG, a Swiss corporation, filed a notice of opposition to registration of applicant's marks, alleging priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, as ground for opposition. Opposer specifically alleges that it is the owner of a registration for the mark UBS for "banking, investment banking, and securities brokerage services;"[2] that it, along with its predecessor, is the prior user of the mark UBS for such services; that opposer has built up extensive and valuable goodwill and consumer recognition in the mark UBS; and that applicant's marks, if used in connection with the identified services, so resemble opposer's mark as to be likely to cause confusion, to cause mistake, or to deceive.

[1] Serial Nos. 76203688 and 76203687, respectively, filed February 2, 2001 and alleging a bona fide intention to use the mark in commerce. In each application, the word "SECURITIES" is disclaimed apart from the mark as shown.
[2] Registration No. 1,573,828 issued December 26, 1989; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

Applicant filed an answer wherein it denied the allegations of the notice of opposition.

The record consists of the files of the involved applications; the testimony deposition of opposer's witness Neil Gluckin (with exhibits); and opposer's notices of reliance on printed publications. Applicant did not take testimony or otherwise offer any evidence on its behalf.

Both opposer and applicant filed briefs on the case. An oral hearing was not requested.

The record shows that opposer UBS AG offers financial services, including banking, investment banking, and securities brokerage services. Opposer is one of the largest financial services companies in the world and has offices throughout the United States and North America. Opposer is the fourth largest stockbroker for individuals in the United States; one of the top five traders of shares on the NYSE; and one of the top ten traders of shares on the NASDAQ.

Opposer has used the UBS mark in connection with its services since 1962. Opposer has spent substantial sums on advertising and promoting its services.[3] Opposer advertises by way of print media, direct marketing,

sponsorship of events and its web site. For well over ten years, opposer has advertised in such magazines and newspapers as *The Economist*, *Fortune*, *Baron's*, *Harvard Business Review*, *The New York Times Sunday Magazine*, *The Wall Street Journal* and

[3] Opposer's advertising/promotional figures have been made of record under seal.

The Financial Times. In addition, opposer has organized and conducted numerous seminars and conferences wherein it has provided investment information to investment professionals and potential investors.

Inasmuch as applicant failed to take testimony or submit any other evidence, what we know about applicant is the information in the application. Applicant is a limited liability company of Nebraska located in Lincoln, Nebraska.

Because opposer, during its testimony period, submitted status and title copies of its pleaded registration, there is no issue with respect to opposer's priority. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont deNemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key factors to be considered are the similarities/dissimilarities between the marks and the similarities/dissimilarities between the goods and/or services.

Turning first to the services, we find that opposer's securities brokerage services and applicant's securities brokerage services are identical.[4] Further, there being no limitations in the recitation of services in either
opposer's registration or applicant's applications, it must be presumed that opposer's and applicant's services would travel in all the normal channels of trade for such services and be offered to all the usual purchasers.

We turn next to a consideration of the similarity or dissimilarity of the marks, in their entireties, as to appearance, sound, connotation and commercial impression. At the outset, we note that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp., v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Further, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the

[4] Although opposer's pleaded registration covers banking and investment services, in its brief on the case, opposer's

commercial impression created by the mark. Disclaimed or otherwise descriptive mater is generally viewed as a less dominant or significant feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, as noted by the Board in Alberto-Culver Co. v. F.D.C. Wholesale Corp., 16 USPQ2d 1597, 1602 (TTAB 1990), where as here, the marks consist of unpronounceable letter combinations, "they may be inherently difficult to remember and thus more susceptible of confusion or mistake than are word marks…."

Applying the above principles to the marks at issue, we find that applicant's marks, UFS SECURITIES and UFS SECURITIES and design, are substantially similar to opposer's mark UBS in sound, appearance and overall commercial appearance. In comparing the marks, it is appropriate to give more weight to the UFS portion of applicant's marks because of the descriptive nature of the word SECURITIES. Indeed, it is the UFS portion of applicant's marks that customers would likely use to refer to applicant's services. The UFS portion of applicant's marks and opposer's UBS mark differ by only the middle letter. The letter combinations UFS and UBS

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likelihood of confusion argument centers on its securities

are unpronounceable and are inherently difficult to remember. Although the UFS portion of one of applicant's marks is depicted in a stylized format, this does not serve to distinguish the marks to avoid a likelihood of confusion.

Further, opposer's evidence of the length and extent of use of its UBS mark, along with the advertising thereof, establish that opposer's UBS mark is a strong mark in the field of securities brokerage services. Thus, it is entitled to a wide scope of protection. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 784 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Applicant's marks, which consist of a very similar combination of letters, come too close to the zone of protection to be accorded opposer's mark.

In view of the foregoing, we find that applicant's marks UFS SECURITIES and UFS SECURITIES and design are so similar to opposer's mark UBS that, if used in connection with services that are identical (securities brokerage services), confusion is likely to result. See, e.g., Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); [confusion found likely in contemporaneous use of TMM and TMS, both for

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brokerage services.

software systems]; Dere v. Institute for Scientific Information, Inc., 420 F.2d 1068, 164 USPQ 347 (CCPA 1970) [confusion found likely in contemporaneous use of I.A.I. for indexes to books and literature and ISI for publications]; Chemetron Corp. v. N.R.G. Fuels Corp., 157 USPQ 111 (TTAB 1968) [confusion found likely in contemporaneous use of NCG for compressed gases and NRG for liquefied petroleum, etc].

Decision: The opposition is sustained as to each of the involved applications.